Hovsepian v. Apple, Inc.

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EXHIBIT 8

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Juanita Brooks (SBN 75934)
Todd G. Miller (SBN 163200)
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

Jonathan E. Singer (SBN 187908)
Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402
Attorneys for Defendants

Attorneys for Defendants Ademia Multimedia, LLC, AEBN, Inc., Audio Communications, Inc., Club Jenna, Inc. Cyber Trend, Inc., Cybernet Ventures, Inc., Game Link, Inc., Global AVS, Inc., Innovative Ideas International, Lightspeed Media Group, Inc., National A-1 Advertising, Inc., New Destiny Internet Group, LLC, VS Media, Inc.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

v.

NEW DESTINY INTERNET GROUP, ET AL.,

Defendants.

AND REFERENCED CONSOLIDATED AND RELATED CASE

Consolidated Cases:
SA CV 02-1040 JW (MLGx)
SA CV 02-1165-JW (MLGx)
SA CV 03-0218-JW (MLGx)
SA CV 02-1048-JW (MLGx)
SA CV 03-0219-JW (MLGx)
SA CV 03-0308-JW (MLGx)
SA CV 03-0271-JW (MLGx)
SA CV 03-0259-JW (MLGx)
SA CV 02-1063-JW (MLGx)

Related Cases:
SA CV 03-1801 JW (MLGx)
SA CV 03-1803 JW (MLGx)
SA CV 03-1804 JW (MLGx)
SA CV 03-1807 JW (MLGx)

DEFENDANTS' CLAIM CONSTRUCTION BRIEF REGARDING UNITED STATES PATENT NO. 6,144,702

Date: May 18-20, 2004
Time: 9:30 a.m.
Ctrm: 9C

Exhibit 8 Page 49

Under these cases, the Court may not rewrite claim 1 and replace "compressor" with "decompressor," as the PTO has done, for causes of action arising before April 15, 2003. The error in claim 1 is not an obvious minor typographical or clerical error that is subject to correction by the Court. This fact is evidenced by the patentee's request for a certificate of correction. If the error is minor, then a certificate of correction was not necessary—the Court could simply correct the claim. The actions of the PTO further demonstrate that the error is not minor. According to the *Patent Office Rules and Practice*, "mistakes which are too trivial, inconsequential, or obviously recognized will not warrant the issuance of a certificate of correction." *Id.* at 1356 (citing § 323 [A][1]). Indeed, if the error was minor and obviously recognized, the PTO would not have issued a certificate of correction. Since the error is not obviously recognized and thus subject to a reasonable debate, the Court may not rewrite the language of claim 1. Accordingly, the claim does not recite what the applicants believed was their "invention" and the claim is invalid under § 112, ¶ 2.

F. "transceiver": The Court Should Construe this Limitation to Mean a Combination of a Transmitter and a Receiver in a Common Housing that Uses Common Circuit Components for Both Transmitting and Receiving.

All three independent claims of the '702 patent recite a "transceiver" in data communication with the transmission system. The IEEE dictionary defines a "transceiver" as: (1) The combination of radio transmitting and receiving equipment in a common housing, usually for portable or mobile use, and employing common circuit components for both transmitting and receiving, and (2) A combination transmitter and receiver in a single housing, with some components being used by both parts. (Ex. NN at 574.) Similarly, Webster's defines "transceiver" as "[*transmitter + receiver*]: a radio transmitter-receiver that uses many of the same components for both transmission and reception." (Ex. MM at 564.) These definitions are consistent with the patent's use of transceiver and the use of the term in prosecution history. Accordingly, the claim limitation may be given its common dictionary meaning. *ACTV*, 346 F.3d at 1091.

G. "temporary storage device": The Court Should Construe this Limitation to Mean a Device that Stores Electronic Data that can be Overwritten.

The term "storage device" appears in the three independent claims of the '702 patent. A few dependent claims, namely claims 14, 16, 41, and 42, further recite "wherein said storage device is a temporary storage device." In the context of the claims, the term "storage device" does not refer to all devices that store, such as shelves, boxes, and drawers. Rather, the storage devices recited in the claims store electronic data. The specification provides a number of examples of electronic storage devices, including computer tapes, computer disks, cartridges, and digital cassette tapes. ('702 patent at 6:16-19, 12:21-29.)

The IEEE dictionary does not include a definition for "temporary storage device." However, the IEEE definition of "temporary storage" and Webster's definition of "temporary" provide guidance. IEEE defines "temporary storage" as "storage locations reserved for intermediate results." (Ex. NN at 573.) Webster's defines "temporary" as "lasting for a limited time only: existing or continuing for a limited time: IMPERMANENT, TRANSITORY." (Ex. MM at 563.) Consistent with these definitions, a "temporary storage device" is a storage device capable of storing data on an intermediate, or impermanent, basis. Put simply, the electronic data in the storage device must be capable of being overwritten. Accordingly, the Court should construe "temporary storage device" to mean a device that stores electronic data that can be overwritten.

H. The '992 patent "ordering means": The Court Should Find the Corresponding Structure to Be the Time Encoder With its Associated Algorithms.

Claim 1 of the '992 patent recites an "ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks." The parties have already submitted proposed constructions for the phrase "sequence of addressable data blocks," which is part of the function performed by the

Exhibit 8 Page 51

Juanita R. Brooks (SBN 75934)
Todd G. Miller (SBN 163200)
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

Jonathan E. Singer (SBN 187908)
Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

Attorneys for Defendants Ademia Multimedia, LLC, AEBN, Inc., Audio Communications, Inc., Club Jenna, Inc. Cyber Trend, Inc., Cybernet Ventures, Inc., Game Link, Inc., Global AVS, Inc., Innovative Ideas International, Lightspeed Media Group, Inc., National A-1 Advertising, Inc., New Destiny Internet Group, LLC, VS Media, Inc.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION, Plaintiff, v. NEW DESTINY INTERNET GROUP, ET AL., Defendants.	Case No. SA CV 02-1040 JW (MLGx) **Consolidated Cases:** SA CV 02-1165-JW (MLGx) SA CV 03-0218-JW (MLGx) SA CV 02-1048-JW (MLGx) SA CV 03-0219-JW (MLGx) SA CV 03-0308-JW (MLGx) SA CV 03-0271-JW (MLGx) SA CV 03-0259-JW (MLGx) SA CV 02-1063-JW (MLGx) **Related Cases:** SA CV 03-1801 JW (MLGx) SA CV 03-1803 JW (MLGx) SA CV 03-1804 JW (MLGx) SA CV 03-1807 JW (MLGx)
AND REFERENCED CONSOLIDATED AND RELATED CASES	**DEFENDANTS' RESPONSIVE CLAIM CONSTRUCTION BRIEF REGARDING UNITED STATES PATENT NO. 6,144,702** Date: May 18-20, 2004 Time: 9:30 a.m. Ctrm: 9C

Exhibit 8 Page 52

for causes of action arising before April 15, 2003. In fact, Acacia's arguments that the error is obvious only serves to undermine its claim that this Court should rewrite it. The Court in *Allen Engineering* rejected this very argument—"it is of no moment that the contradiction is obvious: semantic indefiniteness of claims 'is not rendered unobjectionable merely because it *could* have been corrected.'" *Id.* (emphasis in original). In fact, it is precisely because such errors *can* be corrected (by the PTO) that the Federal Circuit is unsympathetic to patentee arguments that their claims *should* be corrected (by the courts). "Moreover, it does not seem to us to be asking too much to expect a patentee to check a patent when it is issued in order to determine whether it contains any errors that require the issuance of a certificate of correction." *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000); *Superior Fireplace Co. v. Majestic Products Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001). Acacia was free to ask the Patent Office to correct the error in claim 1 at any time after the patent issued on November 7, 2000. That it failed to do so for more than two years after the '702 patent issued, and then only after suing dozens of companies, suggests either that the error is not as obvious as Acacia would have the Court believe or that Acacia failed to diligently review the patents it now contends is infringed by nearly every communication industry in the country.

F. The Court Should Construe "transceiver" to Mean a Combination of a Transmitter and a Receiver in a Common Housing that Users Common Circuit Components for Both Transmitting and Receiving.

There is no apparent dispute between the parties that the ordinary meaning of the claim term "transceiver" is at least "a device that is capable of both transmitting and receiving data." It is axiomatic that such a device must contain both a transmitter and a receiver, which comports with Defendants' proposed construction. Given that the parties also appear to agree that a transceiver is a single device, there is also no apparent dispute that the transmitter and receiver that comprise the transceiver must share a common housing, even though Acacia's proposed construction omits this obvious and inherent limitation. (*See* '702 patent at FIGS. 2b, 6) (illustrating the transceiver as a single box). Where the parties' proposed constructions diverge is in the requirement that the transmitter and the receiver use some common circuit components.

Apparently ignoring its own exhortation that during claim construction the litigants must "be fair with the facts," Acacia quotes in its opening brief the portions of select dictionary definitions for the term "transceiver" that it favors, and omits, without comment, those portions of the dictionary definitions it dislikes. For example, Acacia conveniently omits from its quotation of the *Dictionary of Information Technology*, the first definition of the term "transceiver"—"a radio transmitter and receiver unit in one housing and employing some common circuits, normally used for portable or mobile operations," a definition that is fully in accord with Defendants' proposed construction. (*See* Pl.'s Br. at 26; Block Decl. Ex. 17.) Acacia also ignores the first definition of "transceiver" provided by the *IEEE Standard Dictionary of Electrical and Electronics Terms*, 6th Ed.[7]—"The combination of radio transmitting and receiving equipment in a common housing, usually for portable or mobile use, and employing common circuit components for both transmitting and receiving"—which is also fully in accord with Defendants' proposed construction, in favor of a portion of the third definition provided by that reference. (Pl.'s Br. at 26; Block Decl. Ex. 19.) Acacia also omits from its citation to the *Dictionary of Computing* the third sentence in the definition—"Many communication devices, including *modems, codecs, and terminals, are transceivers." (Pl.'s Br. at 26; Block Decl. Ex. 18.) Modems, an acronym for modulator/demodulator, and codecs, an acronym for coder/decoder, are devices that perform two functions using shared circuitry. Notably, Acacia also failed to mention that in *Inline Connection* the court cited the entire definition of the term "transceiver" found in the *Dictionary of Computing* when it construed "transceiver" as having its ordinary meaning. *Inline Connection Corp. v. AOL Time Warner, Inc.*, 302 F.Supp. 2d 307, 325 n.79 (D. Del. 2004). Unlike the defendant in *Inline Connection*, Defendants urge the Court to adopt the ordinary meaning of the "transceiver" and by the same token reject Acacia's call to adopt a partial definition of the term.

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[7] Acacia's reliance on the 6th Edition of this dictionary, which is copyrighted 1996, is misplaced given that it was published more than 5 years after the priority filing date of the '702 Patent. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003). Notably, Acacia was content to use the 5th Edition of this dictionary in its previous claim construction briefs. Regardless, the primary definition provided by the later edition is identical to the definition provided by the 5th Edition.

G. The Court Should Construe "temporary storage device" to Mean a Device that Stores Electronic Data that can be Overwritten.

In the context of data transmission, one of skill in the art would understand that a temporary storage device is a device in which data may be stored on an impermanent basis. Unlike a permanent form of data storage such as a CD-ROM disk, a temporary storage device may take the form of a hardware buffer, cache, or hard disk drive. As such, the distinction between temporary storage and permanent storage is the ability of the former to permit data to be overwritten.

Acacia proposed construction—"a device into which data may be placed, retained for a limited time, and retrieved," (Pl.'s Br. at 28-29.) while not appearing significantly different than that proposed by Defendants, is so amorphous as to be unhelpful. For example, what is "a limited time"? Does the phrase "a limited time" provide the jury with any more guidance than the word "temporary"? In comparison to the age of the earth, a limited time could be a million years. In this admittedly extreme example, there would be no practical difference between temporary and permanent storage, and the limitation would be rendered a nullity. Defendants' practical construction of this limitation provides the jury with a useful distinction between the two forms of storage device.

H. "Ordering Means": The Court Should Find the Corresponding Structure to Be the Time Encoder With Its Associated Algorithms.

In construing the "ordering means" limitation of the '992 patent, Acacia wrongly contends that the function of "placing items into a sequence of addressable

Juanita R. Brooks (SBN 75934)
Todd G. Miller (SBN 163200)
Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

Jonathan E. Singer (SBN 187908)
William R. Woodford (*pro hac vice*)
Fish & Richardson P.C.
60 South Sixth Street, Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696

Attorneys for Defendants Ademia Multimedia, LLC, AEBN, Inc., Audio Communications, Inc., Club Jenna, Inc. Cyber Trend, Inc., Cybernet Ventures, Inc., ACMP, LLC, Game Link, Inc., Global AVS, Inc., Innovative Ideas International, Lightspeed Media Group, Inc., National A-1 Advertising, Inc., New Destiny Internet Group, LLC, VS Media, Inc. ("Fish & Richardson P.C. Defendants")

Victor de Gyarfas (SBN 171950)
Foley & Lardner LLP
2029 Century Park East, 35th floor
Los Angeles, CA 90067-3021
Telephone: (310) 277-2223; Facsimile: (310) 557-8475

Attorneys for Defendant International Web Innovations, Inc.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION, Plaintiff, v. NEW DESTINY INTERNET GROUP, et al., Defendants.	Case No. SA CV 02-1040 JW (MLGx) **DEFENDANTS' SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF REGARDING THE '992 AND '702 PATENTS**

Exhibit 8 Page 56

ACACIA MEDIA TECHNOLOGIES CORPORATION, Plaintiff, v. INTERNATIONAL WEB INNOVATIONS, INC.; et al., Defendants.	Case No. SA CV 03-0217 JW (MLGx)
AND REFERENCED CONSOLIDATED AND RELATED CASES	**Consolidated Cases:** SA CV 02-1165 JW (MLGx) SA CV 03-0218 JW (MLGx) SA CV 02-1048 JW (MLGx) SA CV 03-0219 JW (MLGx) SA CV 03-0308 JW (MLGx) SA CV 03-0271 JW (MLGx) SA CV 03-0259 JW (MLGx) SA CV 02-1063 JW (MLGx) **Related Cases:** SA CV 03-1801 JW (MLGx) SA CV 03-1803 JW (MLGx) SA CV 03-1804 JW (MLGx) SA CV 03-1805 JW (MLGx) SA CV 03-1807 JW (MLGx)

pattern of treating these claims as the proverbial "nose of wax" to ensnare activities that were never contemplated by the inventors or the USPTO when allowing these patents to issue.

F. The Court Should Construe "transceiver" in Accordance with Its Well-Understood Dictionary Meaning.

The parties have cited several dictionaries that define the term "transceiver," and nearly every dictionary defines the term as a combination of a transmitter and a receiver in a common housing that uses common circuit components for both transmitting and receiving. (May 7, 2004 Block Decl. Ex. 17-19; Ex. MM.) As is now commonplace, Acacia's construction attempts to eliminate the requirement of a transceiver from the claims. Under Acacia's view, as argued at the hearings, a transmitter and a receiver become a transceiver when they are connected with a simple wire. Acacia's construction is entirely at odds with the well-understood meaning of the term "transceiver." The fact that a computer, cable box, or whatever type of device Acacia is concerned with[9] can both transmit and receive does not mean that the device automatically contains a transceiver. Only when the transmitter and receiver use common circuit components to transmit and receive, which is typically the case only when the device both transmits and receives over the same line, can the transmitter and receiver qualify as a transceiver.

Likewise, Acacia's argument that figure 6 of the patent supports its construction of "transceiver" is, in a word, incredible. Figure 6 clearly labels box 201 as the "transceiver" portion of the reception system. If anything, that is the "transceiver" of claim 1. Despite this clear disclosure, Acacia asks this Court to find that its definition of "transceiver" is correct because the "transceiver" of figure 6 is really boxes 201 and 207 combined. This is nonsense. Box 207 is labeled "user/computer interface" and is nowhere discussed in the patent specification. There is no support for including this box as part of the "transceiver" of claim 1 to aid construction of the claim term.

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[9] As pointed out during the May 19 hearing, it is unclear why this limitation is being construed in this case because communication over the Internet is accomplished through modems, which are a type of transceiver. This term appears to be the center of a dispute between Acacia and parties that are not a part of this action.

Accordingly, the Court should construe "transceiver" to mean a combination of a transmitter and receiver in common housing that uses common circuit components for both transmitting and receiving.

G. Acacia's Construction of the "ordering means" Limitation Approaches Claim Construction Backwards—By Looking to the Proposed Structure to Define the Function, as Opposed to the Other Way Around.

The "ordering means" limitation of claim 1 of the '992 patent recites the function of "placing items into a sequence of data blocks." Defendants have construed this function consistent with the plain meaning of the terms and the patent specification to mean placing the formatted data into a continuous series of memory units that contain digital information that can be given an identifier. In an attempt to limit this function to audio and video systems, thereby excluding the transmission of books and documents from the claims (and likely a large number of prior art references), Acacia ignores the plain meaning of the words and contends that the inventors acted as their own lexicographers. Under this pretext, Acacia looks to the specification and, correctly, finds the only "structure" that performs the function is the "time encoder." Acacia reasons that because this is the only structure disclosed, the function must be construed to recite the purported function of the "time encoder." Acacia's analysis and reasoning is backwards.

> "Construction of a means-plus-function limitation involves two steps. *First*, the court must identify the claimed function. . . . *After* identifying the claimed function, the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function." *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002) (emphasis added). Indeed, the Federal Circuit has condemned the analysis applied by Acacia in this case: [T]he trial court determined the function by first searching for the corresponding structures, finding those structures in figures 11 and 12. *We find that justification inadequate, because such a reasoning turns our rule of construction for means-plus-function claims upside down*. The district court's approach essentially starts with a structure, and defines the function in light of that structure. *Our case law, however, requires the exact opposite procedure*: In construing means-plus-function claims, courts must first identify the claimed function using traditional tools of claim construction and then determine the structure corresponding to the identified function."

Omega Engineering, Inc, v. Raytek Corp., 334 F.3d 1314, 1330 (Fed. Cir. 2003) (emphasis added); *see also Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999) (stating that the district court erred by "incorporating unrecited